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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kenneth Gabriel Heiser

HEISE R - 01

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03/19/2007

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EXAMINER

HAILU, TADESSE

ART UNIT

PAPER NUMBER

2173

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/928,009	<b>Applicant(s)</b> HEISER, KENNETH GABRIEL	
	<b>Examiner</b> Tadesse Hailu	<b>Art Unit</b> 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to the AMENDMENT submitted on January 27, 2006 for the above application (09/928, 009).
2. The pending claims 1-7 and 9-10 are examined and rejected as follows.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure is written more as a conception of an invention rather than an invention reduced to practice. There are no flow charts showing the programming steps that one of ordinary skill in the art would need to take to implement the envisioned invention. Also, the disclosure is absent examples and discussion of the type of subjective questions envisioned by the applicant. One of ordinary skill in the art desire to make and user the applicant's invention would be at loss as to what was actually envisioned by the applicant.

Based on this, a rejection under 35 USC 112, first paragraph would be deemed appropriate.

4. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. The purpose of the US Patent system is for the inventor to provide adequate details of their invention so that one of ordinary skill in the art can make and use their invention as envisioned by the inventor/applicant. The invention should be fully, clearly and precisely disclosed if the public is to receive the benefits intended to result from the grant of the patent monopoly. In the present situation, one of ordinary skill would understand the theory behind the invention, and possibly establish the objective questions (as there are ample examples of these question in standard computer programs and on the Internet). One of ordinary skill in the art however, would be at a loss as to the type of subjective questions/responses envisioned by the applicant and how those responses would determine what further questions would be provided to the user to complete the Will.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over "American Wills Created Online," webpage [http: www.Willworks.Com](http://www.Willworks.Com), 1998. (Hereinafter "The website") in view of Goldstein et al (US Pat. No. 5,043,891).

With regard to claims 1, 5 and 7:

The website discloses a method of automatically generating a will document as claimed in the current invention.

The website providing a user with a plurality of input screens (5 screens, pages 1 through 5) to be filled sequential and logical order, wherein said screens include an initial screen for selecting different level of complexity, for example the first screen illustrates personal information entry including name, address, martial status and children, based on the entry of the first screen information, the method will furnish the next (second) entry screen. When the user has completed filling the entry the entire required screen (5 of them), then the method automatically create a Will document to the user. The website also discloses processing said data to calculate net wroth and other parameters relevant to a will or trust; and user will be able to print the created document.

The website however disclose a simple Will form screen which lacks levels of complexity. The website discloses screen fields/questionnaire that are directed to objective things/criteria that are associated with the user. That is,

the form screen does not consider other options or fields/questionnaire that may be associated to the user, such as *what if* options or subjective conditions associated with the user. To put is in claim language, the *American Wills Created Online* fails to teach “...said screen include an initial screen that requires a prefatory step of selecting between at least two levels of complexity based upon both subjective and objective criteria, wherein each of said two levels of complexity will create one or more different screens based on the level of complexity selected...” as claimed in claim 1.

Goldstein discloses a document generation system (e.g., will document, Fig. 10), which employs a definition-based expert system and an editor to produce an output document from a template document and expert system responses. The knowledge base of the expert system consists of a hierarchy of terms and their definitions. To produce an expert response, an inference engine component of the expert system evaluates a term by evaluating all of the definitions for the terms, which are in that term's hierarchy of definitions. In the document generation system, the terms include fragment terms, which are defined as portions of the template document (abstract). Goldstein further discloses a software program for carrying out method of effecting interactive process to create the document, wherein there are at least three hierarchical levels of complexity and interaction initially selected (Fig. 3). As recited in claim 1 and 5, the level of complexity, first, second and third level are

hierarchically interrelated, that is one input data leads to the next input data to form the level of complexity.

The website (American Wills Created Online) and Goldstein are analogous art because they are from the same field of endeavor, document (legal) generation.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the complexity level of interaction described by Goldstein with the simple question/response interaction of the above website. The suggestion /motivation for doing so would have been to provide a better interface to the user and more robust recovery from user errors (Fig. 9, column 16, lines 40-46).

Therefore, it would have been obvious to combine the website (American Wills Created Online) with Goldstein to obtain the invention as specified in claims 1, 5 and 7.

With regard to claim 2:

The website in view of Goldstein further discloses preventing user to jump to another screen before filling all the required (indicated by different color) entry fields (see the screen shot pop-up messages).

With regard to claims 3 and 9:

The website in view of Goldstein discloses also discloses step by step screen data entering/filing, that is, each screen information leads to another related screen information, for example in the first screen if married status is

selected, then the coming next screen, may present a screen comprising spouse information, whereas if a user is single, the next screen information will be related to a single person.

With regard to claims 4 and 10:

The website in view of Goldstein discloses up to five screen information presented to the user (see pages 1 to 5).

With regard to claim 6:

The website, based on the user information inputted, finally will generate the will document (see sample package by clicking *Sample Package* link in page 1).

### **CONCLUSION**

6. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and Figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.
7. Information regarding the status of an application may be obtained from the patent application information retrieval (PAIR) system. Status information



Art Unit: 2173

for published application may be obtained from either Private -PAIR or Public-PAIR. Status information for unpublished applications is available through Private-PAIR only. For more information about the PAIR system, please see [pair-direct.uspto.gov](http://pair-direct.uspto.gov) web site. Should you have questions regarding access to the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:30 – 7:00 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kincaid, Kristine, can be reached at (571) 272-4063 Art Unit 2173 and 2174.

*Examiner Tadesse Hailu*

*Art Unit 2173 – Operator Interface*

*2/4/07*

  
**TADESSE HAILU**  
*Patent Examiner*